

# **TERMINAL DISCLAIMER TO OBIVATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

Docket No.

PG4739

In re Application of: **BIGGADIKE, et. al.**  
 Application No. **10/066,836**  
 Fil d: **02/04/2002**  
 For: **NOVEL ANTI-INFLAMMATORY ANDROSTANE DERIVATIVE**

The owner, SmithKline Beecham Corporation of 100.00 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent g granted on pending second Application Number 09/958,050 filed on 10/02/2001. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

3. Owner/applicant is ☐ Small entity ☒ Large entity

The terminal disclaimer fee under 37 CFR 1.20(d) is \$110.00 and is to be paid as follows:

☐ A check in the amount of the fee is enclosed.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 07-1392.

09/04/2003 PTO suggested wording for terminal disclaimer was

01 FC:1814 110.00 ☒ unchanged. ☐ changed (if changed, an explanation should be supplied.)

*Robert J. Smith*  
Signature

Dated:

*August 7, 2003*

Name and Address of Person Signing

Robert J. Smith  
 Registration No.: 40,820  
 GlaxoSmithKline  
 Corporate Intellectual Property  
 Five Moore Drive  
 PO Box 13398  
 Research Triangle Park, NC 27709  
 Telephone N.: 919-483-9616 Fax No.: 919-483-7988

I certify that this document and fee is being deposited on \_\_\_\_\_ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.6 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature of Person Mailing Correspondence

Ban Younan

Typed or Printed Name of Person Mailing Correspondence

P26/REV01

# **TERMINAL DISCLAIMER TO OBIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

Docket No.

PG4739

In re Application of: **BIGGADIKE, et. al**Application No. **10/066,836**Filed: **02/04/2002**For: **NOVEL ANTI-INFLAMMATORY ANDROSTANE DERIVATIVE**

The owner, **SmithKline Beecham Corporation** of **100.00** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent g granted on pending second Application Number **10/281,735**, filed on **10/28/2002**. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

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2. ☒ The undersigned is an attorney of record.

3. Owner/applicant is ☐ Small entity ☒ Large entity

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☐ A check in the amount of the fee is enclosed.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number **07-1392**.

PTO suggested wording for terminal disclaimer was

☒ unchanged. ☐ changed (if changed, an explanation should be supplied.)

*Robert J. Smith*  
Signature

Dated:

*August 7, 2003*

Name and Address of Person Signing

**Robert J. Smith**

Registration No.: **40,820**

GlaxoSmithKline **07-1392 10066836**

Corporate Intellectual Property

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I certify that this document and fee is being deposited on with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature of Person Mailing Correspondence

**Ban Younan**

Typed or Printed Name of Person Mailing Correspondence

P28/REV01

# Terminal Disclaimer To Obviate A Double Patenting Rejection Over A Prior Patent

Docket No.  
PG4739

In Re Application Of: BIGGADIKE, et. al

Serial No.  
10/066,836

Filing Date  
02/04/2002

Examiner  
BADIO

Group Art Unit  
1616

Invention:

NOVEL ANTI-INFLAMMATORY ANDROSTANE DERIVATIVE

Owner of Record:

SmithKline Beecham Corporation

## TO THE COMMISSIONER FOR PATENTS:

The above-identified owner of record of a 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,537,983. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors and/or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

110.00 3A

*Robert J. Smith*  
Signature

Dated:

*August 7, 2003*

Robert J. Smith / Registration No.: 40,820

Typed or Printed Name

- ☒ Terminal disclaimer fee under 37 C.F.R. 1.20(d) included.  
☒ PTO suggested wording for terminal disclaimer was unchanged.  
☒ Certificate under 37 C.F.R. 3.73(b) is required if terminal disclaimer is signed by the assignee.